

(b) REMARKS

Claims 19, 21, 27, 29 and 30 are in the application, with Claims 21, 27 and 29 being withdrawn from consideration pursuant to an election of species requirement.

Claims 19, 21, 27 and 30 are the independent claims. In the event that allowable subject matter is found, it is requested that Claims 21, 27 and 29 be rejoined under M.P.E.P.

§821.04. An opportunity is requested, if appropriate, to amend Claims 21, 27 and 29 to be commensurate with the allowed claims. Reconsideration and further examination are respectfully requested.

Claims 19 and 30 remain rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1, 3, 6 and 7 of U.S. Patent No. 6,258,666 ('666 patent) in view of U.S. Patent No. 6,100,166 (Sakaguchi) and U.S. Patent No. 5,397,713 (Hamamoto). The rejection is respectfully traversed.

First, Applicants wish to thank the Examiner and the Examiner Supervisor for the professional courtesies extended to Applicants' representatives during a personal interview conducted on July, 28 2003.

Turning to a formal matter, the Interview Summary lists "35.c13513 Div. 1" as the attorney docket number. The attorney docket number should instead be "35.c13584 Div. 1." Applicants will treat the incorrect attorney docket number as a typographical error.

A brief synopsis of the interview proceedings will follow. It is believed that this synopsis is a summary of the interview, in compliance with M.P.E.P. § 713.04. To the extent that the Examiner believes it is inconsistent with his own Interview Summary, entered as paper no. 13, he is requested to point out any inaccuracies or inconsistencies in his next office action.

Additionally, an interview outline, which summarizes Applicants' position, was presented to the Examiner at the interview. A copy of the interview outline is enclosed for the Examiner's convenience.

At the interview, Applicants' representatives responded to the Advisory Action dated June 13, 2003. The Advisory Action maintained the obvious-type double patenting rejection from the Final Office Action dated April 22, 2003. In maintaining the rejection, the Advisory Action alleged that amended Claims 19 and 30 (amended in the Office Action dated February 5, 2003) are not consonant within the scope of the original Group II claims that were subject to a Restriction Requirement in the parent application. The Restriction Requirement was included in the Notice Of Allowance dated December 18, 2000. As support, on page 2, the Advisory Action indicated "the currently pending claims, now require the primary basis of patentability of Group I (i.e. the limitation of rotating a thin film support member to remove semi-conductor film)."

In response, Applicant's representatives explained that under MPEP § 804.1, the line of demarcation between distinct inventions identified by the Examiner in the requirement for restriction had been strictly maintained. The claims of Group I and Group II at the time of restriction were differentiated by several features. As set in the Restriction Requirement, Group I (Claims 1 to 18 and 23 to 26) was drawn to a method of producing a semiconductor thin film. Meanwhile, Group II (Claims 19 to 22 and 27 to 29) was drawn to a method of producing a solar cell. As pointed out by Applicants' representatives, Group I claims were characterized by the step of rotating a thin film support member having a curved surface to assist in peeling a semiconductor thin film from a substrate. Claims 20, 22 and 28 of Group II each was characterized *inter alia*, by the step of rotating a

thin film support member having a curved surface to peel the semiconductor thin film from the substrate. The features distinguishing Group II from Group I are:

- producing a solar cell that uses a thin film; and
- forming an electrode on the back of the thin film.

These features are not found in the Group I claims. Therefore, they determined the line of demarcation since these are the features relied upon by the Examiner directed to the formation of the claimed solar cell rather than to the formation of a thin film by rotating a curved support member. Clearly, the claims of Group I and Claims 20, 22 and 28 of Group II revealed the common feature of rotating the support member. Therefore, this feature could not have been relied on by the Examiner as a line of demarcation as a matter of law. The line of demarcation cannot be found in both Group I and Group II claims. The only possible line of demarcation is the solar cell and electrode.

As set forth at the interview, present Claims 19 and 30 do not cross the line of demarcation because the added feature to these claims, "rotating a thin film support having a curved surface", was present in both Group I and II claims after the Restriction Requirement. As such, the amendments to Claims 19 and 30 did not alter the distinguishing features of Group II, leaving the line of demarcation intact.

The Examiner Supervisor agreed with the above analysis and that the line of demarcation was the solar cell and the electrode features. However, the Examiner Supervisor was somewhat concerned with the Examiner's selection of the line of demarcation. While agreeing that 35 U.S.C. § 1.21 and MPEP § 804.01 protected applicants from the use of U.S. Patent No. 6,258,666 as a reference, the Examiner Supervisor suggested filing a terminal disclaimer or making additional amendments to the independent claims directed to Group II to be sure.

However, neither of these steps are required to be conducted because, as conclusively demonstrated above, U.S. Patent No. 6,258,666 cannot be used as a basis for double patenting since the present claims are consonant with the Restriction Requirement in the parent application. Moreover, the line of demarcation is deemed a valid line for the following reasons. A solar cell is made up of various layers. Some of these layers include various semiconductor thin films (such as a p-layer joined to an n-layer). However, a solar cell requires additional non-semiconductor layers, which, for example, can be electrical contact layers which allow electric current to flow out of and into the cell. Further, such additional layers include an electrode layer and a light-transmitting film layer. Both original Group I and Group II claims contain the step of forming a flexible, adhesive film bonded to a semiconductor thin film (See Claims 3 and 4 compared to Claim 19). However, the Group II claims inherently require that this flexible, adhesive film be light-transmitting, while the Group I Claims do not. This distinction is crucial, since solar cells require such a feature for passing light, but semiconductors do not necessarily require that feature.

Accordingly, this "light-transmitting" requirement for solar cells in Group II further differentiates claims directed to Group II from the claims of Group I. Since amended Claims 19 and 30 are directed to a method of production of a solar cell, Claim 19 explicitly claims a light transmitting film while Claim 30 inherently contains the "light-transmitting" requirement. Therefore, amended Claims 19 and 30 remain consonant with Group II and its differentiating features. In their Response dated May 30, 2003, Applicants challenged the Examiner to cite a PTO rule or case law which supports the proposition that incorporating language from a dependent claim in a restricted out group can render claims non-consonant. PTO policy under MPEP 804.01 is to impose a heavy burden on the Office

to guard against "erroneous" restriction requirements. Once the requirement is advanced and agreed to by applicants, the PTO is forbidden from using the patent which issues against a division. While the office may now have second thoughts about the Restriction Requirement, the framers of 35 U.S.C. § 121 have clearly deemed it best to protect applicants from hindsight concerns by different PTO Examiners on different occasions and to lend certainty and predictability when filing and prosecuting divisions. In view of the foregoing, withdrawal of the obvious-type double patenting rejection is respectfully requested.

It is immaterial that the PTO is not completely satisfied with the Restriction Requirement. Applicants' pending claims are completely consonant with the line of demarcation and it is believed the application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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